

### Remarks

Prior to the issuance of the Final Office Action mailed May 22, 2009, Claims 1-42 were pending. Claims 1-23 and 42 are cancelled herein. Applicants reserve the right to pursue the subject matter of cancelled claims 1-23 and 42 in a continuing application. Upon entry of this amendment, **Claims 24-41 will be pending.**

Applicants submit that no new matter is added as a result of this amendment. Applicants respectfully request reconsideration of the claims in view of the foregoing amendments and following remarks.

### ***Claim Rejections - 35 USC § 102***

Claims 24-41 are rejected under 35 U.S.C. § 102(b) based on an alleged public use or sale of the invention. Specifically, the Office alleges that the PowerPoint Presentation filed by the Applicants in response to the Non-Final Office Action mailed November 24, 2008, as Exhibit A, and described in a Declaration executed by the inventors filed under 37 C.F.R. § 1.131 on February 24, 2009, is alleged to disclose a **public use** (based on photographs and a schematic of components of the invention as provided in PowerPoint pages 17-20).

Additionally, the Office alleges that the PowerPoint presentation filed by the Applicants on February 24, 2009, discloses conception and actual reduction to practice the claimed invention prior to September 10, 2002 (the provisional filing date of the Nelson *et al.*, reference (already of record), and that the **on-sale bar** of 35 U.S.C § 102(b) is triggered **if the invention is both** (1) the subject of a commercial offer for sale not primarily for experimental purposes **and** (2) ready for patenting. Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 67, 48 USPQ2d 1641, 1646-47 (1998) (*emphasis added*). Applicants respectfully traverse.

Applicants attest that the PowerPoint presentation disclosed and described in the Declaration executed by the inventors and filed with the Office on February 24, 2009, was a reproduction of an internal, private, PowerPoint presentation conducted by the inventors at the National Institutes of Health (NIH) prior to the effective filing date of Nelson *et al.*, (already of record). The internal, private, research meeting was attended by Dr. Wilson and an internal scientific review group of invited NIH personnel. Accordingly, Applicants submit that the private and confidential meeting during which the presentation was made was not public, and that the inventors restricted the information, and location to where there was a reasonable

expectation of privacy (see **MPEP 2133.03(a) II. A. 3**). Applicants submit that the information disclosed during the private presentation was not made publicly available prior to the effective filing date of the instant application (January 16, 2004). Pursuant to the MPEP, Applicants submit that mere knowledge of the invention by the public does not warrant rejection under 35 U.S.C. § 102(b) (see **MPEP 2133.03(a) II**). Wherein the MPEP states “35 U.S.C. 102(b) bars public use or sale, not public knowledge (*TP Labs., Inc., v. Professional Postitioners, Inc.*, 724 F.2d 965, 970, 220 USPQ 577, 581 (Fed. Circ. 1984).”

Applicants submit that the **test for public use** as stated by MPEP 2133.03(a) requires that the invention is in **public use** before the critical date **and** is **ready for patenting**.

Applicants submit that there was no public use of the claimed invention prior to the effective filing date of the provisional application (January 16, 2004). The inventors conducted experiments with prototype components (some of which are shown on pages 18-20 of Exhibit A filed February 24, 2009) in their laboratories and thus took reasonable steps to ensure the use of the claimed invention was not “public use” or in “public view” (see MPEP 2133.03(a) A. 1. - “the fact that the device was not hidden from view may make the use not secret, but nonsecret use is not *ipso facto* ‘public use’ activity.”

While the presentation submitted February 24, 2009, does disclose a schematic of the invention and also provides photographic evidence pertaining to components of the claimed apparatus, the presentation does not represent a “**public disclosure**” (under MPEP 2133.03) because the data presented in the PowerPoint presentation was not **publicly available** prior to the effective filing date of the instant application (January 16, 2004). Accordingly, for at least the foregoing reasons, Applicants submit that the claimed invention was **not in public use nor was there a public disclosure** prior to January 16, 2004 (the filing date of the provisional application).

With respect to the Office’s conclusion regarding that the on-sale bar of 35 U.S.C § 102(b) is triggered **if the invention is both** (1) the subject of a commercial offer for sale not primarily for experimental purposes **and** (2) ready for patenting, Applicants provide the following remarks.

Applicants respectfully submit that for the **on-sale bar** under 35 U.S.C. § 102(b) to be triggered, the Applicants must have **made an offer for sale** not primarily for experimental purposes use **and** that the invention was **ready for patenting**. Applicants submit that no offer

for sale for the claimed invention was made prior to the effective filing date of the instant application (January 16, 2004). Accordingly, Applicants submit that bar of patentability is not met in this instance because there was no offer for sale prior to the critical date. Applicants respectfully submit that satisfying **only one of the criteria related to the two-prong test for on sale-bar activity is not sufficient to prohibit patentability of the claimed invention.**

Applicants submit that there was no public use or offer for sale for the claimed invention prior to the effective filing date of the instant application. Accordingly, Applicants request withdrawal of the rejection of claims 24-41 under 35 U.S.C. § 102(b).

### ***Cancelled claims***

In an effort to facilitate examination, Applicants have cancelled withdrawn claims 1-23 and 42. Applicants reserve the right to pursue the subject matter of the cancelled claims in a continuation application.

### ***Interview Summary***

Applicants thank Examiner Lorengo for participating in a useful telephonic interview with the Applicants' representative, Dr. Zara Doddridge, on June 23, 2009. Applicants' representative discussed with Examiner Lorengo the newly raised rejection under 35 U.S.C. § 102(b), the content of the Declaration and PowerPoint presentation filed by the Applicants on February 24, 2009 (in response to the Non-Final Office Action issued November 24, 2008), and suggestions for providing remarks to facilitate examination.

### **Conclusion**

Applicants believe the present application is ready for allowance, which action is requested. If any matters remain to be discussed before a Notice of Allowance is issued, Examiner is respectfully requested to contact the undersigned for a telephone interview at the telephone number listed below. This is a renewed request for an Interview. In addition, the Applicants respectfully reserve the right to Appeal.

Respectfully submitted,

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